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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/525,129	06/09/2005	Richard David Hughes	05-158	2938

20306 7590 10/24/2006

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EXAMINER

AURORA, REENA

ART UNIT PAPER NUMBER

2862

DATE MAILED: 10/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/525,129	HUGHES, RICHARD DAVID	
	<b>Examiner</b>	<b>Art Unit</b>	
	Reena Aurora	2862	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 9/28/06.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 11 - 26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 11 - 26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 September 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                    | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)         | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                          |

### DETAILED ACTION

This communication is in response to amendment received on 09/28/06.

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 11 - 26 are rejected under 35 U.S.C. 102(b) as being anticipated by Philips et al. (6,137,281).

As to claims 11 and 12, Philips et al. (hereinafter Philips) discloses a magnetic back to back locator comprising providing in the neighborhood of the object (51, fig. 1c) a variable strength magnetic field, sensing the magnetic field strength at a plurality of positions relative to the object (51) using an array of Hall effect magnetic sensors (18, 21, 22), the array of Hall effect sensors (18, 21, 22) being associated geometrically with a machining guide (6), such that the machining guide (6) and the array of sensors (18, 21, 22) are fixed positionally one relative to the other, interrogating the sensors to determine the value of the field strength at at least the majority of the sensors, analyzing the sensor responses to determine the displacement between the object (51) and the machining guide (6), and moving the array (18, 21, 22) and machining guide to a position in which the displacement is a minimum (col. 5, lines 36 - 48).

As to claim 17, Philips discloses a magnetic back to back locator comprising means to generate a variable strength magnetic field (51), a base member (12) adapted to be placed on or against the surface, means in the base member defining a machining guide (6), an array of Hall effect sensors (18, 21, 22) located relative to the machining guide (6), and means for collecting and analyzing outputs (36) from at least some of the sensors to provide an indication of the variation of the magnetic field associated with the object relative to the position of the base member (col. 5, lines 36 - 48).

As to claims 13 - 16, Philips discloses that once the machining guide (6) is located adjacent the surface at that point of the surface immediately and centrally overlying the object in question, the position of the array (18, 21, 22) and machining guide (6) is fixed (col. 3, lines 64 – col. 4, line 10).

As to claims 18 – 20 and 22 - 26, Philips discloses that the fixing means (44) adapted to lock the position of the base member (12) and the object (51) relative to one another.

As to claims 21 and 26, Philips discloses that the array of Hall effect sensors (621, 623, 632, 624) is a cruciform array (Note fig. 6a).

### ***Response to Arguments***

Applicant's arguments filed on 09/28/06 have been fully considered but they are not persuasive.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies

(i.e., on page 9, 2<sup>nd</sup> paragraph “Philips does not disclose determining displacement (e.g., distance, direction, etc.) between where one is and where one wants to be, when trying to locate a non-visible object.”). And on page 10, 3<sup>rd</sup> paragraph “Philips does not disclose providing any sort of indication of in what way (e.g., direction, distance, etc.) a base member may be misaligned with a magnetic field associated with a non- visible object.” and “the apparatus of claim 17 would indicate to a person or to a machine which way to move a sensing apparatus to align it with a magnet on the other side of an opaque surface.”) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Reena Aurora whose telephone number is 571-272-2263. The examiner can normally be reached on Monday - Friday, 7:00 - 3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, E. Lefkowitz can be reached on 571-272-2180. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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